

REMARKS

Reconsideration of the subject application in view of the present amendment is respectfully requested.

With the present amendment, claims 1 and 4 have been amended to yet more clearly define the present invention.

Based on the foregoing amendment and the following remark, the application is deemed to be in condition for allowance, and action to that end is respectfully requested.

Claims 1 and 3-5 are rejected under 35 U.S.C. 103(a) as unpatentable over Guzzella (5,584,679) in view of Steffen (6,123,158) in further view of Moolenaar et al. (5,385,572). It is respectfully submitted that claims 1 and 3-5 are patentable over the combination set forth in the Office action.

Specifically, claim 1 recites a strictly mechanical rpm-dependent clutch in the force-transfer path between the electric motor and the transmission for transmitting torque from the electric motor to the transmission. Claim 1

further recites that a result of braking of the electric motor, a torque transfer from the electric motor to the transmission is interrupted when the rpm of the motor is less than the rpm of the clutch. No such clutch is disclosed in the prior art applied for rejection of the claims. The prior art, including Guzzella, does not disclose a clutch an operation of which depends on the clutch's own rpm.

Considering the prior art, Guzzella, which corresponds to EP 666 148 B1 discussed in the preamble of the specification, both being based on the same German Priority Application DE 43 44 817.8, discloses a pure electromagnetic clutch (5). The difference between an electromagnetic clutch, which is controlled by the motor-controlled electronics, and a strictly mechanical rpm-dependent clutch consists in that the mechanical, rpm-dependent clutch is self-controlled (see the paragraph bridging pages 4-5 of the specification). While Guzzella may contemplate use of a mechanical clutch, nowhere is it disclosed that such a clutch is rpm-dependent. Moreover, a pure mechanical rpm-dependent clutch of a type disclosed in the specification would be incompatible with an intended operation of the control system of Guzzella. For Guzzella, it is irrelevant what type of a clutch is used.

It is noted that “whereby” clause in claim 1 states a condition that is material to patentability and, therefore, should not be ignored (Hoffer v. Microsoft Corp., Fed. Cir., No. 04-1103, 4/22/05).

In view of the above it is respectfully submitted that the combination of Guzzella, Steffen, and Moolenaar does not make the present invention as defined by claim 1 obvious, and claim 1 is patentable over said combination and is allowable:

Claim 3 depends on claim 1 and is allowable as being dependent on an allowable subject matter.

Claim 4 relates to a method of operating the tool of claim 1, relies for its patentability on the same inventive features as claim 1 expressed in the method form language, and is allowable for the same reasons claim 1 is allowable.

Claim 5 depends on claim 1 and is also allowable.

CONCLUSION

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance, and allowance of the application is respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place the case in condition for final allowance, then it is respectfully requested that such amendment or correction be carried out by an Examiner's Amendment and the case passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, the Examiner is invited to telephone the undersigned.

Respectfully submitted,



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